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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,163	09/01/2000	Hiroshi Mikitani	KAK-001	5466
23353 7590 01/29/2008 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER				
BORISSOV, IGOR N				
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3628				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/653,163

Applicant(s)

MIKITANI ET AL.

Examiner

Igor N. Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/27/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8-13 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-13 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Amendment received on 11/27/2007 is acknowledged and entered. Claims 5, 7, 14, 15 have previously been cancelled. Claims 1, 10, 16, 17, and 19-21 have been amended. Claims 1-4, 6, 8-13 and 16-26 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-13 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196).

Independent Claims

Claims 1 and 16, Strandberg teaches a method and system for utilizing a computer network for conducting telemarketing campaign, comprising:

recording means (database 200) for recording information concerning customers, each of which has an electronic mail address [0018];

allocating uniquely an electronic mail address to each of participants [0018]; [0019];

sending by a host a first electronic mail in which an electronic mail address is affixed as a unique access key to each one of a plurality of specified participants [0019];

recognizing said specified participants for a lottery by receiving a second electronic mail sent back to said electronic mail address from each of said participants [0020]; [0023].

Strandberg does not specifically teach that *said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers (stored in the database) in advance so as to specify participants for the lottery; and notifying each one of the participants of their result of said lottery.*

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers in advance so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Claim 10. Strandberg teaches a system for utilizing a computer network

for conducting telemarketing campaign, comprising:

storing means for storing information of customers [0018];

means for uniquely allocating a keyword to be entered in a page of a URL,
to each of participants [0018]; [0019];

means for sending an electronic mail in which the keyword is affixed as a unique access key, to each of the participants [0019];

means for recognizing an application from each of said participants when said participant accesses the page of said URL and enters the keyword [0020]; [0023].

Strandberg does not specifically teach that said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers *in advance* so as to specify a main group for performing the lottery; and notifying each one of the participants of their result of said lottery.

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers in advance so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to

waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Claim 17. Strandberg teaches a system for utilizing a computer network for conducting telemarketing campaign, comprising:

storing means for storing information of customers [0018];

means for uniquely allocating a URL to each of participants [0018]; [0019];

means for sending an electronic mail in which the URL is affixed as a unique access key, to each of the participants [0019];

means for recognizing an application from each of said participants when said participant accesses the page of said URL via e-mail [0020]; [0023].

Strandberg does not specifically teach that said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers in advance so as to specify a main group for performing the lottery; and notifying each one of the participants of their result of said lottery.

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Claims 19, 20 and 21. Strandberg teaches a method and system for utilizing a computer network for conducting telemarketing campaign, comprising:

- storing information of customers in a database [0018];
- specifying participants for the campaign from a database[0018];
- providing at least one electronic mail address [0018];
- allocating uniquely an electronic mail address to each of participants

[0018]; [0019];

- sending by a host a first electronic mail in which an electronic mail address is affixed as a unique access key to each one of a plurality of specified participants [0019];

- recognizing said specified participants for a lottery by receiving a second electronic mail sent back to said electronic mail address from each of said participants

[0020]; [0023].

Strandberg does not specifically teach that said telemarketing campaign includes conducting a lottery; that said system includes means for limiting the customers in advance so as to specify a main group for performing the lottery; and notifying each one of the participants of their result of said lottery.

Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15 – C. 12, L. 8). Furthermore, Wendkos explicitly teaches identifying a specific group of customers eligible for the lottery from the database of all customers, thereby disclosing the “advance” feature (C. 10, L. 35-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg to include that said telemarketing campaign includes *conducting a lottery*, as disclosed in Wendkos, because it would advantageously stimulate interest of the audience to the campaign, thereby increase participation and potentially increase revenue. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include that said system includes *means for limiting the customers so as to specify a main group for performing the lottery*, as disclosed in Wendkos, because it would advantageously allow achieving specific business objectives, including keeping award expenditures within budget and not to waste resources (Wendkos; C. 11, L. 28-30; C. 10, L. 51). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg and Wendkos to include *notifying each one of the participants of their result of said lottery*, as disclosed in Wendkos, because it would advantageously provide convenience for the participants of not inquiring about the results by themselves.

Dependent Claims

Claims 2-4, 6, 11-13, 18 and 22, see reasoning applied to claims 1, 10, 16, 17, 19 and 20.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strandberg in view of Wendkos and further in view of Sarno (US 6,024,641).

Claim 8. Strandberg in view of Wendkos teach all the limitations of claim 8, except specifically teaching that the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize.

Sarno teaches a system for on-line lottery gaming, including means for registering participants for said lottery via a Web site, means for conducting said lottery and means for notifying said participants of a result of said on-line lottery, wherein said means for registration includes means for entering an electronic address of a participant (C. 7, L. 23-26) and wherein said means for notification includes means for sending said notification via an electronic mail (C. 6, L. 14-16), and further wherein the URL of the page informing said result is separated into one for a winner of a prize and the other for a loser in winning the prize (Figs. 3B, 6; C. 6, L. 14 – C. 7, L. 32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg in view of Wendkos to include that the URL of the page informing said result is separated into one for a winner of a prize and the other for a loser in winning the prize, as disclosed in Sarno, because it would advantageously allow to simplify reading of the lottery results.

Claim 9, Sarno teaches said system and method wherein by entering said access keyword and a mail address to which said access keyword is sent into the page informing said result, a page for the winner of the prize and a page of the loser in winning the prize can be accessed (C. 6, L. 14 – C. 7, L. 32). The motivation to combine references would be to simplify the access to the results of the lottery.

Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strandberg in view of Wendkos and further in view of Libby et al. (US 6,193,605).

Claims 23-26, Strandberg in view of Wendkos teaches all the limitations of claims 23-26, except specifically teaching that that said means for conducting the lottery generates random number on the basis of the number of said participants, thereby obtaining the results of the lottery.

Libby et al. teaches a lottery system, wherein the identities of the grand prize participants may be stored in, for example, a grand prize data table (step 318) and the winner of the grand prize may be randomly selected by the random number generator 38 (step 320). Once the winner of the grand prize is selected, the name of the winner is broadcasted after the race (step 322) (C. 7, L. 62 – C. 8, L. 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strandberg in view of Wendkos to include that that said means for conducting the lottery generates random number on the basis of the number of said participants, thereby obtaining the results of the lottery, as disclosed in Libby et al, because it would advantageously facilitates the conducting of said lottery.

Response to Arguments

Applicant's arguments filed 11/27/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to disclose means for limiting the customers (stored in the database) *in advance*, it is noted that Wendkos explicitly teaches said feature. Specifically, Wendkos teaches that a specific group of customers can be identified (for conducting a lottery) based on certain criteria (C. 10, L. 35-53). The motivation of doing so would be not wasting resources for not promising customers (see a discussion above).

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

01/23/2008